UNITED STATES PATENT AND TRADEMARK OFFICE

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10/010,630	11/07/2001	Yuji Toyomura	MAT-8198US	4831

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EXAMINER
LE, DEBBIE M

ART UNIT	PAPER NUMBER
2168	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
	10/010,630	TOYOMURA ET AL.
Office Action Summary	Examiner	Art Unit	
	DEBBIE M. LE	2168	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>19 March 2008</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1,3-6,8,12,14-32 and 34-58</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1,3-6,8,12,14-32 and 34-58</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) <u>59-82</u> are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

Applicant's amendents filed on 3/19/08. Claims 1,3-6,8, 12, 14-32, 34-58

are elected for prosecution without traverse.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the
United States before the invention thereof by the applicant for patent, or on an international application
by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this
title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act

of 1999 (AIPA) and the Intellectual Property and High Technology Technical

Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting

directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior

to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 3-6, 8, 14 and 32 are rejected under 35 U.S.C. 102(e) as being

anticipated by Ando et al (U.S Patent 6,341,196).

As per claim 1, Ando disclose [a] memory media for storing data for access by an

application program being executed on a data processing system comprising (Fig. 11,

col. 15, lines 37-63):

a plurality of directories at a directory level, each of said directories limited

to storing files of a respective one of a plurality of file formats, so that not more

than said respective one of said plurality of file formats are permitted to be stored

in each of said directories (Fig. 5, col. each 5, lines 7-15, col. 17, lines 7-26, a

directory stores its own data type that is video directory stores video file, still picture

directory stores still picture file, audio directory stores audio file);

a further directory at said directory level, said further directory for

storing files in other than said plurality of file formats (Fig. 5, user-set subdirectory).

As per claim 3, Ando teaches wherein said directory level is immediately under a

root directory (Fig. 5, directories are listing under the root directory).

As per claim 4, Ando teaches wherein said the memory media are memory card

(Fig. 11, col. 15, lines 37-53)

As per claim 5, Ando teaches wherein said further directory is further for storing

files in one of said plurality of file formats (Fig. 5, user-set directory).

As per claim 6, Ando discloses a portable information terminal

comprising memory for storing data for access by an application program being

executed by said terminal and detachable to and from a terminal body of the

information terminal comprising (Fig. 11, col. 15, lines 37-63):

means for forming a plurality of directories at a directory level, each of

said directories limited to storing files of a respective one of a plurality of file

formats, so that not more than said respective one of said plurality of file formats

are permitted to be stored in each of said directories (Fig. 5, col. each 5, lines 7-15,

col. 17, lines 7-26, a directory stores its own data type that is video directory stores video file, still picture directory stores still picture file, audio directory stores audio file);

a further directory at said directory level, said further directory for storing files in other than said plurality of file formats (Fig. 5, user-set subdirectory).

As per claim 8, Ando discloses a portable information terminal comprising carryable memory media for storing data for access by an application program being executed by said terminal and detachable to and from body of the terminal (Fig. 11, col. 15, lines 37-63),

wherein said carryable memory media is provided with a plurality of directories at a directory level, each of said directories limited to storing files of a respective one of a plurality of file formats, so that not more than said respective one of said plurality of file formats are permitted to be stored in each of said directories (Fig. 5, col. each 5, lines 7-15, col. 17, lines 7-26, a directory stores its own data type that is video directory stores video file, still picture directory stores still picture file, audio directory stores audio file);

a further directory at said directory level, said further directory for storing files in other than said plurality of file formats (Fig. 5, user-set directory)

if a file to be stored conforms to said plurality of directories, said portable information terminal stores the relevant file in the carryable memory media at a data area corresponding to one of said plurality of file formats, if a file to be stored does not conform to said portable information

terminal stores the file in the carryable memory media at a further data area corresponding to said further directory (Fig. 5, col. 17, lines 1-26, each directory is assigned a unique directory name and file name corresponding to each collection of file data and stored in said unique directory name).

As per claim 14, Ando teaches an operation section for operation by a user, wherein **based on operation by said user of the operation section, at least one file is stored in a data area corresponding to said plurality of directories and at least another file is stored In a further data area corresponding to said further directory** (Fig. 11, Fig. 5).

As per claim 32, Ando discloses **[a] method for managing files in a portable information terminal comprising carryable memory media for storing data for access by an application program being executed by said terminal and detachable to and from body of the terminal** (Fig. 11, col. 15, lines 37-63), comprising the steps of:

A) forming a plurality of directories at a directory level, each of said directories limited to storing files of a respective one of a plurality of file formats, so that not more than said respective one of said plurality of file formats are permitted to be stored in each of said directories (Fig. 5, col. each 5, lines 7-15, col. 17, lines 7-26, a directory stores its own data type that is video directory stores video file, still picture directory stores still picture file, audio directory stores audio file);

   **B) forming a further directory at said directory level said further
directory for storing files in other than said plurality of file formats** (Fig. 5, user-
set directory)

   **C) storing a file in said carryable memory media at a data area
corresponding to one of said plurality of directories or said further directory** (col.
17, lines 1-26, collections of file data are stored in the assigned directory name
corresponding to file name).

Claim Rejections - 35 USC § 103

   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

   This application currently names joint inventors. In considering patentability of
the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of
the various claims was commonly owned at the time any inventions covered therein
were made absent any evidence to the contrary. Applicant is advised of the obligation
under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was
not commonly owned at the time a later invention was made in order for the examiner to
consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)
prior art under 35 U.S.C. 103(a).

Claims 12, 15-31, 34-58 are rejected under 35 U.S.C. 103(a) as being
unpatentable over Ando et al (U.S Patent 6,341,196) in view of Black et al (US patent
7103602 B2) (hereinafter "Black").

As per claim 12, Ando does not explicitly teach, but Black teaches wherein an
attached file attached to electronic mail received is stored in said carryable memory
media at a data area corresponding to said further directory (Fig. 3, element 56). Thus,
it would have been obvious to one of ordinary skill in the art at the time invention was
made to combine the teachings of the cited references to allow the attached file
attached to electronic mail received is stored in said carryable memory media at a data
area corresponding to said further directory as disclosed by Black because it would
improve data management system to organize and process a large volume of various
types of data files and provide efficient way of reviewing and manipulate the data stored
in specific directory, as suggested by Black (col. 2, lines 1-4) and Ando (col. 4, lines 1-
25)

As per claim 15, Back teaches separation means for separating an e-
mail with the attached file received through said communication means into the
e-mail document file and the attached file (Fig. 3, element 56), wherein

said e-mail document file is stored in said carryable memory media at a data
area corresponding to one of said plurality of formats (col. 6, lines 49-52), and

said attached file is stored in said carryable memory media at a data area
corresponding to other than said plurality of formats (col. 6, lines 55-56).

As per claim 16, Black teaches wherein storage of said e-mail document file and said attached file is based on operation of a user (col. 5, lines 4-5).

As per claim 17, Black teaches file extraction means for extracting said files (col. 6, lines 57-64).

As per claim 18, Black teaches control means, wherein said control means controls at least one process among the following processes to be performed on said extracted file for deleting the file, shifting the file to a data area of said carryable memory media, which data area corresponding to a different directory other than the original directory, and storing it in there, transmitting the file as an attached file; and exhibiting it on a display (Fig. 2, element 44, de-duplicating).

As per claim 19, Black teaches wherein said file extraction means extracts the file that conforms to said specific file form, based on the file expansion index (col. 7, lines 10-25).

As per claim 20, Black teaches wherein said file extraction means extracts the file that conforms to said specific file form, based on the file inner structure (col. 7, lines 10-25).

As per claim 21, Black teaches wherein said file extraction means extracts the file that conforms to said specific file form, through a plurality of steps of extraction (col. 7, lines 10-25).

As per claim 22, Black teaches input means for inputting conditions for file extraction, wherein said file extraction means extracts, among those which

conform to said specific file form, the file that satisfies said conditions for file extraction (col. 7, lines 1-9).

As per claim 23, Black teaches control means, wherein said control means controls at least one process among the following processes to be performed on said extracted file, for deleting the file; shifting the file to a data area of said carryable memory media, which data area corresponding to a different directory other than the original directory, and storing it in there; transmitting the file as an attached file; and exhibiting it on a display (Fig. 2, element 44).

As per claim 24, Black teaches wherein said file extraction means extracts the file that conforms to specific file form through the following process; a primary extraction based on the file expansion index, and an extraction once again based on the inner structure of those extracted by said primary extraction (Fig. 3, element 56, 58, e-mail file type and attached data file type).

As per claim 25, Iida teaches a video processing function, said directory for storing specific format files containing a directory for storing video information form files, wherein a video information file is extracted from both of the data areas of said carryable memory media; one data area Is that which corresponds to the directory for storing video information form files and the other data area is that which corresponds to said directory for storing non-specific format files (col. 17, lines 30-51).

As per claim 26, Black teaches terminal extracts the Exif format image file through either one of the following processes; extracting the JPG image file from

data area of said carryable memory media based on the directory for storing non-specific format files, or extracting the image file from said carryable memory media based on the JPG expansion index . jpg of the directory for storing non-specific format files; and a process of checking the Inner structure of said image file extracted (col. 8, lines 35-67).

As per claim 27, Black teaches information terminal prints the extracted Exif format file upon an operation made by a user (col. 9, lines 20-22).

As per claim 28, Black teaches wherein the portable Information terminal transmits the attached file stored in a data area corresponding to said further directory via said communication means, accompanying an e-mail (col. 6, lines 47-52).

As per claim 29, Black teaches wherein said file control means deletes a file which had been stored in a data area corresponding to said further directory after it is transmitted via said communication means (Fig. 2, # 44, de-duplicating).

As per claim 30, Black teaches wherein said file control means shifts a file that had been stored in a data area corresponding to said directory for storing non-specific format files after it was transmitted via said communication means, to a data area of said carryable memory media that corresponds to a certain directory other than said original directory for storing specific format files and said original directory for storing non-specific format files (a master user list, folder directory (root), col. 6, lines 49-50).

As per claim **31**, Black teaches wherein said instruction means issues one of the following instructions based on operation of the operation section by a user, after a file stored in a data area corresponding to said directory for storing non-specific format files is transmitted via said communication means, regarding how the transmitted file be handled:

leaving the transmitted file in said directory for storing non-specific format files; deleting the transmitted file; shifting the transmitted file to a data area of said carryable memory media that corresponds to a certain specific directory other than said original directory for storing specific format files and said original directory for storing nonspecific format files (Fig. 2, de-duplicating, a master user list, folder directory (root), col. 6, lines 49-50).

Claims **34-43, 50, 51, 58** have similar limitations as claims 12, 15-24, therefore, they are rejected under the same subject matter.

Claims **46-48** have similar limitations as claim 3, therefore, they are rejected under the same subject matter.

Claim **49** is rejected under the same rationale as stated in claim 6 argument.

Claims **52, 53, 56, 54, 55** and **57** are rejected under the same rationale as stated in claim 1 arguments.

Claims **44-45** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ando et al (U.S Patent 6,341,196) in view of Black et al (US patent 7103602 B2)

(hereinafter "Black") and further in view of Ito et al (US Patent Application Pub. No. 2005/0219559 A1).

Ando and Black do not explicitly teach wherein the portable Information terminal is a portable telephone unit. But Ito teaches the portable Information terminal is a portable telephone unit (para. 0140). Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to combine the teachings of the cited references to implement the portable Information terminal is a portable telephone unit because it would provide users of Ando's system and Black's system to retrieve and/or transmit a file (picture) from a small directory (memory card's directory from the mobile phone) even without a digital camera.

Claim 45 has similar limitation as claim 44, therefore, it is rejected under the same subject matter.

Response to Arguments

Applicant's arguments with respect to communication filed on December 10, 2007 and March 19, 2008 have been considered but are moot in view of the new ground(s) of rejection over Ando et al (U.S Patent 6,341,196) in view of Black et al (US patent 7103602 B2) (hereinafter "Black") and further in view of Ito et al (US Patent Application Pub. No. 2005/0219559 A1).

Conclusion

The prior art made of record, listed on form PTO-892, and not relied upon, if any, is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEBBIE M. LE whose telephone number is (571)272-4111. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Vo can be reached on (571) 272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DEBBIE M LE/
Primary Examiner, Art Unit 2168
July 5, 2008